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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/686,039	10/15/2003	Erich Kast	BE-118	6415

7590 10/05/2004  
Friedrich Kueffner  
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EXAMINER	
COMSTOCK, DAVID C	
ART UNIT	PAPER NUMBER

3732

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/686,039

**Applicant(s)**

KAST ET AL.

**Examiner**

David Comstock

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Foley et al. (6,193,757).

Foley et al. disclose an intervertebral implant 80 for placement between vertebrae (see Figs. 13-17 and col. 8, line 65 - col. 9, line 10). The implant comprises two sidepieces 82,84 joined together at one end 98 and that are free at the opposite end 90,94. A slider device 313,316 vertically distracts the sidepieces. The sidepieces are formed from a single piece of resilient material, which may be plastic (id.). The outside surfaces of the sidepieces that face the vertebrae are configured to converge, i.e. to tend toward each other, toward the free end of the sidepieces in an initial position for distraction, due to their inherent resiliency that tends to urge the arms--which include the outer surfaces--in a direction toward each other. The slider tool passes through an opening 99 in the joined end of the implant (see Figs. 13 and 17). The slider 313,316 releasably locks, by a threaded engagement 99, in an end position in which the sidepieces are distracted. The inner surfaces 87,89 of the sidepieces converge both in the

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sense that they tend toward each other due to the resiliency of their material and in the sense that they angle toward each other (see Fig. 17). The slider is at least capable of being positioned flush with an outer surface of the device when the sidepieces are spread if one desired to have it do so, since the implant material is flexible and resilient and the slider is long enough to allow its end to reach a point that is flush with an outer surface of the implant. The implant is configured for placement in a lateral half-space because of its narrow, uniform shape. The implant has an oblong--i.e. having the shape of or resembling a rectangle or an ellipse--vertical opening 86 within and along the inside wall of the sidearm (see Fig. 13).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foley et al. (6,193,757) in view of Baccelli et al. (2003/0028249).

Foley et al. disclose the claimed invention except for the plastic being polyetheretherketone (PEEK). Baccelli et al. disclose an implant 2 formed from PEEK in order to be transparent to X-rays and facilitate inspection of the implant (see Fig. 1 and par. 50). It would have been obvious to a person of ordinary skill

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in the art at the time of the invention to form the implant of Foley et al. from PEEK, in view of Baccelli et al., in order to be transparent to X-rays and to facilitate inspection of the implant.


**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

oe

D. Comstock  
01 October 2004

  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
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